Remarks

This Amendment is responsive to the Office Action of **June 7, 2004**. Reexamination and reconsideration of **claims 1-36** is respectfully requested.

Summary of The Office Action

Claims 1-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoh (U.S. Patent No. 5,255,353) in view of Washington et al. (U.S. Patent No. 6,515,682 B1).

Please note that Applicant believes that the Office Action incorrectly cited the Itoh reference on page 2. It seems that Shibuya, et al. (U.S. Patent No. 5,579,416) was the intended reference since citations appearing in the Office Action correspond to Shibuya, and not to Itoh. Therefore, the present response will address the rejection as Shibuya in view of Washington et al.

The Present Claims Patentably Distinguish Over the References of Record

Independent Claim 1

Independent claim 1 is directed to a user interface comprising an actuatable icon representing a shadow direction for an object that when actuated actuates the rendering of a shadow having the shadow direction from the rendered object.

The Office Action cites Shibuya as teaching claim 1 except for an actuatable icon and refers to shadow information 33 and column 1, lines 48-62, and Figs. 3A and 6. Shibuya describes the shadow information 33 as "The shadow information 33 comprises a continuous parameter 40, a discontinuous parameter 41, and the like. The shadow parameter consists of a hatching parameter 42a, a shadow amount parameter 42b, and the like." (see column 1, lines 58-62).

Although Shibuya discusses shadow information 33, it fails to mention any way of controlling a shadow direction such as an actuatable icon that represents a shadow direction as

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recited in claim 1. In fact, Shibuya describes directional parameters for other features but fails to mention a shadow direction. For example Shibuya describes setting a tilt direction for a font (see column 2, lines 1, and 8-9) and setting a magnifying direction for character data (see column 9, line 25). However, Shibuya fails to discuss setting a shadow direction because such a feature was not considered. Thus, Shibuya fails to teach or suggest any way of controlling a shadow direction.

One of ordinary skill would understand, from reading Shibuya, that the shadow direction is fixed and cannot be controlled. Since tilting direction and magnification direction were discussed, Shibuya could have discussed shadow direction but did not. Therefore, it is reasonable to conclude that it was neither the purpose nor intent of Shibuya to provide a feature associated with shadow direction. As such, it would not be obvious to one of ordinary skill to modify Shibuya to provide such a feature. Therefore, Shibuya fails to teach or suggest the recited features of claim 1 and claim 1 patentably distinguishes over Shibuya.

Regarding the Washington patent, the Office Action uses its teachings for using icons in a user interface. Modifying Shibuya to include icons may be obvious, but it is not obvious to provide an icon for a feature that does not exist. As explained above, Shibuya fails to teach or suggest any way of setting a shadow direction and thus modifying Shibuya with the icons of Washington still fails to teach or suggest the recited features of claim 1.

With reference to Itoh (U.S. Patent No. 5,255,353), which was cited but not applied, Itoh teaches a three-dimensional shadow processor. Itoh describes setting a shadow length (see column 3, lines 15-29) but fails to consider any feature associated with a shadow direction. Indeed, Itoh only teaches that the shadow is created in "a predetermined direction." (see column 1, line 17 and line 30). Therefore, the shadow direction is fixed and not changeable.

Since claim 1 recites features not taught or suggested by the references, individually or combined, claim 1 patentably distinguishes over the references. Accordingly, dependent claims 2-10 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 11

Independent Claim 11 recites a user interface comprising an actuatable icon ... representing a direction for rendering a shadow... As explained above, Shibuya fails to teach or suggest a feature associated with representing a direction for rendering a shadow. Furthermore, using the teachings of Washington still fail to teach or suggest the recited features of claim 11 because the icons of Washington do not provide such a feature.

Since claim 11 recites features not taught or suggested by the references, individually or combined, claim 11 patentably distinguishes over the references. Accordingly, dependent claims 12-17 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 18

Independent Claim 18 is directed to a method of displaying a rendering of a shadow. Claim 18 recites displaying an actuatable icon as a menu item on the menu, the icon representing a selection of a shadow direction for the predetermined object; and upon the actuation of said menu item by said selection, rendering a shadow having the appearance of being cast from the rendered object in the selected shadow direction.

As explained previously, Shibuya does not teach or suggest selecting a shadow direction and thus fails to teach or suggest displaying an icon that represents a selection of a shadow direction as presently claimed. The teachings of Washington do not cure this short coming since Washington fails to teach or suggest displaying icons associated with selecting a shadow direction.

Since claim 18 recites features not taught or suggested by the references, individually or combined, claim 18 patentably distinguishes over the references. Accordingly, dependent claims 19-26 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 27

Independent Claim 27 is directed to a shadow rendering system. Claim 27 recites a host computer configured to perform a program including a number of steps like displaying an actuatable icon that represents a selection of a shadow direction, rendering a shadow...in the

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selected shadow direction, and displaying the calculated shadow...in the selected shadow direction.

Shibuya fails to teach or suggest selection of a shadow direction as recited in claim 27 and thus fails to teach or suggest a shadow rendering system including the other recited features associated with a selected shadow direction. Washington fails to cure this short coming based on the previous discussions of Washington.

Since claim 27 recites features not taught or suggested by the references, individually or combined, claim 27 patentably distinguishes over the references. Accordingly, dependent claims 28-33 also patentably distinguish over the references and are in condition for allowance.

Conclusion

For the reasons set forth above, **claims 1-36** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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